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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,450	10/29/2003	Eiji Sakaguchi	2912-114	4555
6449	7590	06/16/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			COLE, ELIZABETH M	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,450

Applicant(s)

SAKAGUCHI

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-14, 19-20 are of copending Application No. 10/367,977 in view of JP 2000103022 A. 10/367,977 discloses a non-halogen containing floor covering comprising a fibrous backing layer, an intermediate resin layer which contains a filler material and a surface layer. 10/367,977 differs from the claimed invention because it does not disclose a second resin layer between the first resin layer and the backing layer which contains less filler than the first resin layer. JP '022 teaches that in floor coverings which comprise a surface layer and a resin layer comprising a filler the resin layer may actually comprise multiple layers wherein the outer layers comprise less filler in order to facilitate bonding while the inner resin layer comprises additional filler to reduce costs and increase strength. See paragraphs 0046-0048 of the machine translation. It would have been obvious to have employed multiple intermediate resin layers as taught by JP '002 as the intermediate resin layer in 10/367, 977, motivated by the expectation that

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this would enhance the bonding of the resin layers and also produce an economical and strong laminate.

This is a provisional obviousness-type double patenting rejection.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-052654 in view of JP 2000103022. JP '654 discloses a halogen free floor covering comprising an intermediate resin layer comprising a 100-400 parts of filler to 100 parts of resin, (paragraph 0011) wherein the resin may be an olefin resin such as polyethylene or polypropylene, ethylene-vinyl acetate, ethylene copolymers, as well as various rubbers (paragraph 0028) wherein the middle layer has a thickness of 1-5 mm, (paragraph 0032), , a surface layer having a thickness of 30-1000 micrometers which also may comprise an olefin resin as well as other thermoplastic resins and elastomers, (paragraph 0016), and a backing layer comprising a fabric such as a knitted woven or nonwoven fabric, such as a spun bonded polypropylene fabric, (paragraph 0035). The surface layer may be a monolayer and may have a laminated structure, (paragraph 0010 and 0017). The resin layer may comprise decorative additives such as coloring agents, (paragraph 0032). JP '654 differs from the claimed invention because it does not disclose the presence of a second intermediate resin layer having less filler than the first intermediate layer, the relative thicknesses of the layers, and the relationship

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between the degree of elasticity of the surface layer and the intermediate resin layer in terms of the formula $1.0 < X/Y < 2.0$. With regard to the presence of the second intermediate layer containing less filler than the intermediate layer, JP '022 teaches that in floor coverings which comprise a surface layer and a resin layer comprising a filler the resin layer may actually comprise multiple layers wherein the outer layers comprise less filler in order to facilitate bonding while the inner resin layer comprises additional filler to reduce costs and increase strength. See paragraphs 0046-0048 of the machine translation. It would have been obvious to have employed multiple intermediate resin layers as taught by JP '002 as the intermediate resin layer in JP '654, motivated by the expectation that this would enhance the bonding of the resin layers and also produce an economical and strong laminate. With regard to the thickness of the resin layer, JP '654 does teach that the intermediate resin layer should have a thickness of 1-5 mm. Since JP '002 teaches that the outer layers which bond the filler-containing layer to other layers of the laminate are provided more for bonding while the filler-containing layer is provided to strengthen the laminate as well as to decrease the cost of the laminate, it would have been obvious to have made the outer bonding layers thinner than the inner filler containing layer, motivated by the expectation that this would facilitate bonding while maintaining the strength and cost saving benefits provided by the filler containing layer. With regard to the particular formula, while JP '654 does not disclose the elasticity of the layers, since JP '654 employs the same materials, it is reasonable to presume that the materials would therefore satisfy the formula.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 02.26879 A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c